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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,567	05/12/2005	Jean-Francois Biegun	CAC.P0046	6534

7590 02/26/2007
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EXAMINER

WOODALL, NICHOLAS W

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/534,567

Applicant(s)

BIEGUN ET AL.

Examiner

Nicholas Woodall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12,13 and 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on 11/30/2006.

Drawings

2. The drawings were received on 11/30/2006. These drawings are acceptable.

Claim Objections

3. Claim 19 is objected to because of the following informalities: claim 19 stated being dependent from claim 14, which was cancelled in the amendment. The examiner believes the claim is meant to be dependent from claim 21, and will be understood as such for examination purposes. Appropriate correction is required.

4. Claims 20 and 21 are objected to because of the following informalities: the claims state, "comprising a part in a plastic material...", the examiner believes this claims should read as, "comprising a part of made of a plastic material..." and will be understood as such for examination purposes. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 15, 17, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morr (U.S. Patent 5,124,106) in view of Merrill (U.S. Publication 2003/0119935).

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Regarding claim 21, Morr discloses a device comprising a part made of a plastic material. The bottom part of the plastic body will come into contact with the bone to be removed as the device is being used. Regarding claims 15 and 17, Morr discloses a device further comprising a metal insert at least partly embedded in the plastic material. Morr does not disclose the device being made from a plastic hard enough to remove bone or that deteriorates when placed in an autoclave at a temperature of at least 137 degrees Celsius. Merrill teaches a device comprised of a radiation treated ultra high molecular weight polyethylene, which can be treated with gamma radiation (page 1 paragraph 10), that is harder than bone and has a melting point of 137 degrees Celsius (page 4 paragraph 051) in order to improve wear resistance of the device (page 1 paragraph 09). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Morr from a radiation treated ultra high molecular weight polyethylene in view of Merrill in order to improve wear resistance of the device.

Regarding claim 19, Morr discloses the invention as claimed except for the device including a part of the device being comprised from a shape memory material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Morr with a part made from shape memory material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

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7. Claims 12, 13, 15, 16, 18, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard (U.S. Patent 5,817,097) in view of Merrill (U.S. Publication 2003/0119935).

Regarding claim 21, Howard discloses a device comprising a part made from a plastic material (column 4 lines 50-54). The plastic part is capable of being in contact with bone while the device is being used. Regarding claims 15-16 and 18, Howard discloses a device further comprising at least one insert, a magnet that can be completely embedded in the plastic material of the device (column 6 lines 62-67 and column 7 line 1). The magnet can be made from any proper material including metal. Howard fails to disclose a device wherein the plastic material is harder enough to remove bone when the device is used (claim 1). Merrill teaches a device comprised of a radiation treated ultra high molecular weight polyethylene, which can be treated with gamma radiation (page 1 paragraph 10), that is harder than bone and has a melting point of 137 degrees Celsius (page 4 paragraph 051) in order to improve wear resistance of the device (page 1 paragraph 09). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Howard from a radiation treated ultra high molecular weight polyethylene in view of Merrill in order to improve wear resistance of the device.

Regarding claim 20, the combination of Howard and Merrill disclose a device that can be inherently manufactured by a method comprising the steps of providing a body having the shape of an ancillary and comprising a part made of plastic material which is to come into contact with bone to be removed while the device is used to remove bone

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and exposing the plastic material to beta or gamma rays, so that after this exposition, the plastic material is hard enough to remove bone when the device is used and when the device is put into an autoclave at a temperature of at least 137 degrees Celsius the device deteriorates and can not be used. Regarding claim 12, the combination of Howard and Merrill disclose a device that can be inherently manufactured by a method as discussed above further including the step of embedding at least one insert of a material harder than bone in the plastic material. Regarding claim 13, the combination of Howard and Merrill disclose a device that can be inherently manufactured by a method as discussed above further including the step of wherein the at least one insert is fully embedded in the plastic.

Response to Arguments

8. Applicant's arguments with respect to claims 11, 12, 14, 15, and 17-19 have been considered but are moot in view of the new ground(s) of rejection. Claims 11 and 14 have been cancelled and replaced by claims 20 and 21. The examiner has presented new grounds of rejection for claims 12-13 and 15-21 as discussed above. The new grounds of rejection were necessitated by amendment. Claims 20 and 21 have added functional language that requires the plastic body being hard enough to remove bone while being used, which was not required in the previous set of claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW

EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER